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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,813	08/19/2003	Vipul Narain Roy		3317

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EXAMINER

KAHELIN, MICHAEL WILLIAM

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 10/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/642,813

Applicant(s)

ROY, VIPUL NARAIN

Examiner

Michael Kahelin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Examiner maintains the position that the disclosure of the prior-filed application, Application No. 60/406,987, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The elements lacking support are: two distinct radiological poles covered in insulating material, a telemetry wand, and compatibility with an internet/network connection facility. Although the excerpts cited by Applicant are noted, these excerpts are broad and do not contain the specific subject matter claimed. Please note that though priority to the 60/406,987 application will not be considered, these elements are present in the non-provisional application (the instant Application No. 10/642,813) and will have a priority date consistent with the filing date of the application (i.e. 8/19/2003).

Drawings

2. Based on Applicant's remarks concerning Figure 3A in the communication filed 7/23/2006, the figure should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

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applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The amendments to the specification are acknowledged and accepted. Please include a description of Fig. 3A in the "Brief Description of Several Views".

Claim Objections

4. Claims 17, 28, 29, and 30 are objected to because of the following informalities: "the" should be inserted between "facility" and "patient" in claim 17; "the" should be inserted before "PPM/ICD" in claim 28; one instance of "wherein" should be deleted and "the" should be inserted before "software" in claim 29; and "the" should be inserted before "software" and "an" should be inserted before "PPM/ICD" in claim 30.

Appropriate correction is required.

5. Claims 18, 19, 22, 24 and 25 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Because the magnet and coil are already set forth in claim 17 and the claims allow them to be "any other shape", the claims place no further limitations on the magnet and coil. In regards to claim 24, it is already specified in claim 17 that the coil can move in

multiple planes. In regards to claim 25, it is already specified in claim 17 that the box has two radiologically distinct poles.

Claim Rejections - 35 USC § 112

6. Claims 17-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. In regards to claim 17, "PPM/ICD box" is vague because it is unclear whether this is the housing for the PPM/ICD or some other object. The fact that the box has radiological markers implies that it is the internally implanted PPM/ICD housing, but the statement that the PPM/ICD will be supplied with programming software and a telemetry wand implies that at least a portion of the box is external. The limitation "if internal small generator fails" is vague because it would seem that the PPM/ICD box has two radiologically distinct poles regardless of whether the generator fails. The phrase "patient is connected" should be changed to "PPM/ICD is connected" because the claim is, in effect, claiming a patient, which is nonstatutory subject matter. The phrase "round the clock" is unclear because it is a slang phrase. It is suggested to recite something similar to "at all times". The phrase "these changes" is vague because it is unclear to what "these" refers. Further, "the battery" and "the PPM/ICD box" are lacking antecedent basis. It is suggested to first positively state that these elements are part of the invention, then further limit them by how they function and how they are connected

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to the other elements. For instance, claim 17 may be recited in a manner similar to the following, but it is noted that this does not suggest or imply allowability of the claims:

A permanent pacemaker or ICD system comprising:

A PPM/ICD box;

A small electric power generator within the PPM/ICD box

comprising a small magnet and coil wherein the coil

encircles the magnet and the magnet is adapted to rotate;

A battery within the PPM/ICD box adapted to be recharged by the

small electric power generator;

Radiological markers... (i.e. insert the structural relationship to the

other elements and any functional limitations)

A large external circular coil...

Programming software...

A telemetry wand...

Etc.

8. In regards to claim 20, it is specified in claim 17 that the coil surrounds the magnet. It is unclear how both the magnet surrounds the coil and the coil surrounds the magnet.

9. In regards to claim 30, the claim is vague because it is unclear whether the centre is actually part of the claimed invention or only compatible with the system (i.e. the system is adapted to be used with the centre). Further, "will offer" is vague because

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it is unclear whether the centre actually offers 24 hour service or "will offer" the service at some future time.

Response to Arguments

10. Applicant's arguments filed 7/23/2006 in regards to the prior art rejections have been fully considered but they are not persuasive.

11. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

12. This action is a **final rejection** and is intended to close the prosecution of this application. Applicant's reply under 37 CFR 1.113 to this action is limited either to an appeal to the Board of Patent Appeals and Interferences or to an amendment complying with the requirements set forth below.

If applicant should desire to appeal any rejection made by the examiner, a Notice of Appeal must be filed within the period for reply identifying the rejected claim or claims appealed. The Notice of Appeal must be accompanied by the required appeal fee of \$250.

If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims

or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

A reply under 37 CFR 1.113 to a final rejection must include the appeal from, or cancellation of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Kahelin whose telephone number is (571) 272-8688. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (571) 272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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GE
GEORGE R. EVANISKO
PRIMARY EXAMINER

10/23/06